). The phrase "same patentable
-7 CFR 1.601(n) (emphasis in

...dition as an invention "B" when
102) or is obvious (35 U.S.C. 103)
ion "B" is prior art with respect to
: patentable invention with respect
: new (35 U.S.C. 102) and non-
on "B" assuming invention "B" is

ın of the Interference Division
l Interferences confirms that
ıce-in-fact exists involves a
r v. *Fujita*, 53 USPQ2d 1234,
USPQ2d 1478 (BPAI 2000):

resumed to be prior art vis-a-vis
tion of Party A must anticipate or
rty B *and* the claimed invention of
the claimed invention of Party A.
ıen regardless of who ultimately
PTO] assures itself that it will not
ıvention.

ısistent with examples set out
npanying the final rule, Patent
it 49 FR 48416 on December
lirected to Examples 3, 4 and

patentable claims 1 (engine), 2
platinum piston). Application F
12 (8-cylinder engine). Claims 1
2 of application F define the same
ın E defines a separate patentable
tion E and claims 11 and 12 of
ured, there would be one count
id claims 11 and 12 of application
: count. Claim 3 of application E
the count.
patentable claims 1 (engine), 2
platinum piston). Application H
nd 15 (engine with a platinum
l claim 11 of application H define
f application G and claim 15 of
invention from claims 1 and 2 of
H. If an interference is declared,
ine) and Count 2 (engine with a
ion G and claim 11 of application
ount 1. Claim 3 of application G
ignated to correspond to Count 2.
atentable claims 1 (engine), 2
and 3 (combination of an engine,
pplication K contains patentable
engine and a carburetor), and 33
and an air filter). The engine,
and combination of an engine,
tentable invention. The combina-
tic converter define a separate
rference is declared, there would
plication J and claims 31, 32, and
correspond to the count. Claim 3
s corresponding to the count.

inged so that Application E
ith a platinum piston), no
:e there is no interference-in-
and claims 1-2 of Application
of Application F would not
ıe with a platinum piston of
similar rationale, if the facts
pplication J contained only
a carburetor, and a catalytic
declared because there is no
of Application J and claims

suggested that there may be
:e an interference should be
ın to expand the nature of
a resource consequence for
:es involved in interferences.
ıurces of the Board of Patent
o resolve interferences, not-

withstanding the fact that there are many more appeals than interferences. USPTO has received many reports that interferences involve considerable costs for applicants and patentees. Additionally, there is no desire on the part of USPTO, and no authority under the law, to turn interference proceedings under 35 U.S.C. 135(a) into pre-grant oppositions or post-grant cancellations. Accordingly, USPTO is reluctant, at this time, to expand the circumstances under which an interference might be declared or maintained absent a compelling reason.

This notice provides interested parties with an opportunity to comment and make out a case that the nature of interferences should be expanded beyond the current practice. If a one-way patentability analysis is sufficient to establish an interference-in-fact, would it be possible to have an interference with two counts as set out in Example 4, reproduced above? How would having an interference between claim 1 of application G and claim 15 of application H of Example 4 square with the holding of *Nitz v. Ehrenreich*, 537 F.2d 539, 543, 190 USPQ 413, 416-17 (CCPA 1976)? If a one-way patentability analysis is sufficient, what would it take to establish that there is no interference-in-fact in a given case?

Comment Format

Comments should be submitted in electronic form if possible, either via the Internet or on a 3 1/4-inch diskette. Comments submitted in electronic form should be submitted as ASCII text. Special characters, proprietary formats, and encryption should not be used.

Authority: 35 U.S.C. 2(b)(2)(A), 3(a)(2), 135(a).

December 14, 2000

Q. TODD DICKINSON
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

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Drawings in Patent Application Publications and Patents

The United States Patent and Trademark Office (USPTO) has revised its patent drawing review procedures to implement the eighteen-month publication of patent applications. See Changes to Implement Eijzhteen-Month Publication of Patent Applications, 65 Fed. Reg. 57023, 57026-27 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office 63, 65-66 (Oct. 10, 2000). While the Office of Initial Patent Examination (OIPE) will perform an initial review of drawings to see if the drawings are acceptable for publication purposes by inspecting the drawings to see if they can be effectively reproduced by digital image scanning, the standard of review employed by OIPE is such that most drawings will be considered acceptable (even if they are designated by applicant as "informal"). If OIPE requires corrected drawings, the corrected drawings filed in reply to the OIPE requirement will be included in any patent application publication or patent. Otherwise, in most situations, patent application publications and patents will reflect the quality of the drawings that are included with a patent application on filing unless applicant voluntarily submits better quality drawings as set forth below.

If applicant desires to have better drawings included in a patent application publication than the drawings that were submitted with the application on filing, applicant may submit replacement drawings on paper either within one month from the filing date of the application or fourteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later. The replacement paper drawings must be filed in an envelope addressed to BOX PGPUB DRAWINGS, Commissioner for Patents, Washington D.C. 2023 1, with a petition under 37 CFR 1. 182 requesting entry of the drawings and the petition fee set forth in 37 CFR 1. 17(h), in the time period set forth above. If such drawings are properly and timely submitted, the patent application publication will include the replacement drawings. Replacement drawings that are received later than this date may be

included in the patent application publication, where practicable, if the USPTO has not started the patent application publication process.

Box PGPUB DRAWINGS should only be used for filing replacement drawings for inclusion in a patent application publication. The replacement drawings should be accompanied by a transmittal letter identifying the application to which the replacement drawings are directed and should have either an authorization to charge the petition fee or other payment of the petition fee. Replacement drawings received in this special box will be scanned and included in the electronic document which will be used for the patent application publication. After the replacement drawings are scanned for the patent application publication, they will be made of record in the application file. Replacement drawings that are not mailed to BOX PGPUB DRAWINGS, are not filed with the appropriate petition fee, or are not timely submitted will be routed to, and made of record in, the application file without scanning and will not be included in the patent application publication, but may be included in any patent. Replacement drawings for other applications must be submitted in a different envelope.

An applicant may also provide a copy of the application, as amended during prosecution (including better replacement drawings), for publication via EFS. See 37 CFR 1.215(c) and Changes to Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. 57024, 57036 and 57059, 1239 Off. Gaz. Pat. Office 63, 74 and 94.

Questions regarding this notice may be directed to Karin Tyson, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, by telephone at (703) 306-3159, by facsimile at (703) 872-9411, or by e-mail to karin.tyson@uspto.gov.

December 18, 2000

NICHOLAS P. GODICI
Commissioner for Patents

DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
37 CFR Parts 1 and 104
RIN 0651-AB22

Legal Processes

AGENCY: Office of the General Counsel, United States Patent and Trademark Office, Commerce.

ACTION: Proposed rule.

SUMMARY: The United States Patent and Trademark Office proposes rules relating to civil actions and claims involving the Office. Specifically, the rules will provide procedures for service of process, for obtaining Office documents and employee testimony, for indemnifying employees, and for making a claim against the Office under the Federal Tort Claims Act.

DATES: Submit comments on or before January 22, 2001.

ADDRESSES: Send all comments:
1. Electronically to "PBORulemaking@uspto.gov, Subject: "Legal Process Rules";
2. By mail to Director of the United States Patent and Trademark Office, Box 8, Washington, DC 20231, ATTN: Legal Process Rules; or
3. By facsimile to 703-305-9373, ATTN: Legal Process Rules.

A copy of any comments regarding the information collection requirements may instead be sent to the Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, 725 17th Street, NW., Room 10235, Washington, DC 20503.

FOR FURTHER INFORMATION CONTACT: Richard Torczon, 703-305-9035.

SUPPLEMENTARY

Comment format

The Office prefers t
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in electronic form s
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Background

The Patent and
(Public Law 106-11
the Patent and Trade
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General Provisions

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Friedman v. Lehma